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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,670	07/24/2000	Pradip Mukerji	6407.US.p2	7619

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EXAMINER

RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 09/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/624,670

Applicant(s)

MUKERJI ET AL.

Examiner

Delia M. Ramirez

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 6-7, 25, 29-46, and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-5, 8-24, 26-28, 47 and 48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Status of the Application

Claims 1-49 are pending.

It is noted that the examination of the instant application has been assigned to a different Examiner in Group Art Unit 1652.

Applicant's election of Group I, claims 1-5, 8-24, 26-28, and 47-48 drawn to polynucleotides, vectors, host cells, transgenic animal, fluid from said transgenic animal, and a method of making a polypeptide, in Paper No. 11 filed on 7/23/2002 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 6-7, 25, 29-46, and 49 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Supplemental Restriction Requirement

The instant Office Action is a supplemental restriction requirement. The previous Office action (Paper No. 10, mailed 6/18/2002) was a restriction requirement of pending claims 1-49. This supplemental requirement is at the discretion of the examiner (see MPEP 802 and 37 CFR 1.142) and is deemed appropriate and necessary in view of the plurality of claimed patentably distinct inventions.

The original restriction requirement presented nine different inventions (Groups I-IX). Since Group I is drawn to polynucleotides, transgenic animals and fluids from said animal, Group I is further restricted as follows:

- IA. Claims 1-5, 8-24, 47-48, drawn to the polynucleotide of SEQ ID NO: 5, vectors, and host cells comprising the polynucleotide of SEQ ID NO: 5, method of use of the polynucleotide, classified in class 435, subclass 193.
- IB. Claims 27-28, drawn to a transgenic non-human animal and a fluid from said animal, classified in class 800, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

1. Groups IA and IB each comprise a chemically unrelated structure capable of separate manufacture, use and effect. In the instant case each group comprise chemically and physically unrelated structures. The polynucleotide of Invention IA is a nucleic acid whereas the transgenic animal of Invention IB is a multicellular organism. The polynucleotide has other uses besides being introduced in the transgenic animal such as a hybridization probe or to make the corresponding polypeptide of Group II. Furthermore, the transgenic animal can be used for in vivo studies or to make antibodies or recombinant proteins.
2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
3. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement can be traversed (37 CFR 1.143). In the instant case, since Applicants have previously elected without traverse the generic Group I, either Group IA or IB must be elected in response to this action.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


5. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 308-4556. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
September 20, 2002


REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP 1000
1652